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R E M A R K S

Firstly Applicant herewith resubmits the response to the previous (final) office action upon which the Examiner's Advisory Action was based. It is believed that the arguments presented in that paper are still applicable, and reference will be made below to them.

Based on the remarks made by the Examiner in the Advisory Action Applicant believes that the following are true and Applicant will not address them based on the final office action:

- Obviousness double patenting rejection has been resolved.
- The lack of evidence relating to laboratory tests described in the previously submitted Declaration has been resolved.

Rejection of Claims 1-10 under 35 U.S.C. 102(b) as anticipated by WO01/34702A2.

Because Applicant does not provide explicitly for a minimum amount of thermally conductive filler, and states the filler concentration typically may be from 5 to 65%, it is stated that this reference anticipates the present claims because it specifies carbon may be present up to 10% by weight. The Examiner has apparently not understood the explanation provided by the Applicant in the last paragraph on page 3 of the previous response.

The present claims do indirectly specify what the minimum amount of any thermal conductor must be by specifying what the minimum thermal conductivity of the composition must be. As stated in the previous response this minimum amount will depend on the particular thermally conductive filler chosen. If the filler has a very high thermal conductivity less will be required than if that thermal conductivity is lower (other factors such as the shape of the filler particles may also be important). The comparative example described in the previously submitted Declaration shows that 8% carbon on the composition is not even close to providing the required 1.0 W/m°K required in the present claims (and therefore 10% wouldn't either). It is not inherent in any composition containing 5% (or even 10% or 20%) of a thermally conductive filler that it will have the required thermal conductivity. This will depend on the particular filler chosen. For carbon obviously a much higher value than 10% is

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required to obtain the needed minimum thermal conductivity. Thus this reference does not anticipate the present claims.

Claims 1-10 are rejected under 35 U.S.C. 102(b) as anticipated by Nakamichi (UC5,028,461).

The Examiner again states that Nakamichi teaches the use of 63% carbon fiber or carbon black. The Examiner did not address the Applicant's argument stated in the paragraph bridging p. 4 and 5 of the previous response, pointing out that using the Examiner's method of calculation, over 100% of ingredients other than the polymer (PPS) was present in the composition, and that Nakamichi must have used different methods of calculating composition percentages in his patent. The Examiner is specifically requested to address this issue raised by the Applicant, unless of course this rejection is withdrawn.

The Examiner states that Applicant's "admission" that 25% [of carbon] "may be enough to give the required thermal conductivity" by itself cements this rejection seems premature. In order to anticipate a claim, a reference must disclose with "sufficient specificity" the limitations of that claim, see the next to last full paragraph on p. 4 of the previous response for the *Atofina v. Great Lakes Chemical Corp.* case. Although mentioned in reference to the previous rejection, it is equally applicable here too.

Nakamichi does not specifically disclose that his compositions require a certain minimum amount of carbon black to achieve a minimum thermal conductivity. Rather he discloses that carbon black is an exemplary type of filler, and that such fillers in general may be present in a 2-25% amount. Thus one of ordinary skill in the art would not "prefer" carbon black over any other filler, specifically mentioned or not. It is Applicants contention that Nakamichi does not disclose with sufficient specificity either the minimum amount of a thermally conductive filler that is required to achieve the desired thermal conductivity, nor even that a thermally conductive filler in general is needed.

Put another way, one of ordinary skill in the art would not be aware of Applicant's invention from the disclosure of Nakamichi because Nakamichi does not disclose either the "reasoning" behind, or specific compositions of, the present invention sufficiently for one of ordinary skill to discern the present invention. Since "Rejection for anticipation requires, as first step, that all elements of claimed invention

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be described in single reference, and such reference must describe applicant's claimed invention sufficiently to have placed person of ordinary skill in possession of it." *In re Spada*, (CAFC 1990) 15 USPQ2d 1655, Nakamichi does not anticipate the present claims.

Note - Applicant did not admit that a composition containing even 25% carbon black had the required minimum conductivity, merely that it may have such conductivity.

In view of the foregoing, allowance of the above-referenced application is respectfully requested.

Respectfully submitted,



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